

REMARKS

Claims 1-24 are all the claims pending in the application. Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks,

Claim Objection

The Examiner objected to claim 7 for an informality. Applicants submit that the self-explanatory amendment to claim 7 obviates this objection.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-24 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicants submit that the present claims amendments overcome these rejections and respectfully request that the Examiner withdraw these rejections. A summary of the claim amendments is provided below:

(1) Claims 1, 2, 7, 8, 13, 14, 19 and 21 - amended to remove the “may be” language from the claim;

(2) Claims 9 and 10 - amended to remove the term “may be”;

(3) Claim 13 - amended to correct for antecedent basis;

(4) Claim 11 - amended to correct for antecedent basis;

(5) Claim 19 - amended to recite that one of the assigned unique based station identifiers is duplicatively assigned. Applicants submit that this claim is not vague and ambiguous. From the amended claim language, Applicants submit that one of ordinary skill in the art would understand that the unique identifier assigned to a base station is later duplicatively assigned to at least two base stations;

(6) Claim 20- amended to remove the term “may be”;

(7) Claim 21 - amended to remove the term “may be”;

(8) Claim 22 - amended to remove the term “may be” and, additionally, to correct for a lack of antecedent basis;

(9) Claim 23 - amended to remove the term “may be”;

(10) Claims 3, 4, 15 and 16 - amended to remove the term “may”;

(11) Claims 8, 9, 10, 11, 12, 20-14 - amended to remove the term “may”.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claims 9-12 and 20-24 under § 103(a) as being unpatentable over the admitted prior art (APA). Applicants traverse this rejection as follows.

The Examiner contends that the APA teaches or suggests most of the features recited in the rejected claims, but concedes that the APA fails to teach or suggest, the determination of the maximum base station number as in claims 9 and 20-22; the assigning of the base station identifier in a predetermined order as in claims 10, 11 and 23; and duplicatively assigning the base station identifier that is already used in claims 12 and 24.

Claims 9 and 20-22

To compensate for the above noted deficiencies of the APA, the Examiner takes Official Notice that the “determination of a maximum number of base stations used is well known in the art, such maximum number base stations is known in the CDMA prior art as the active set.” Then, the Examiner concludes that since Official Action is taken, it would have been obvious to a person of skill in the art at the time the invention was made to determine the number of base stations that have the link set up with the mobile station of the APA being the active set so that the judgment of the transmitting base stations of the APA during handoff would be based on the actual links set up dictated by the active set.

In response, Applicants submit that the Examiner has failed to establish *prima facie* obviousness because the Examiner has provided no objection motivation, suggestion or teaching to modify the APA. Rather, the only motivation to modify the APA as suggested by the Examiner comes from Applicants own disclosure. Thus, the Examiner merely takes the APA and suggests modifying it based a hindsight analysis derived from Applicants’ own teachings. Additionally, because the Examiner’s reliance on “Official Notice” is improper, aside from the

APA, there is no objective support for the Examiner's attempted *prima facie* case of obviousness.

The APA teaches that a base station control unit for controlling base stations having links set up determines the identifiers of the plurality of base stations having the links set up. (*Specification*, p. 3, lines 22-28). Further, the APA teaches that the base station identifiers are base station unique information for identifying individual base stations. (*Id.*). The APA also teaches that code words representing combinations of base station identifiers are defined, and that the base stations and the mobile stations have this information. (*Id.* at p.3, line 28 through p. 4, line 2). Finally, because the APA teaches that all the base stations have information on the defined code words corresponding to all the combinations of the base station identifiers in advance, all the base station identifiers may not necessarily be used. Accordingly, in the APA, the judgment is performed by comparing a code word to a set of code works that constitute all possible base station combinations; not just the base station combinations corresponding to base stations having actual links set up.

Therefore, the APA teaches that for each base station, code words representing combinations of base stations identifiers are already set up. Additionally, this information resides in each of the base stations and mobile stations. However, Applicants respectfully submit that this teaching fails to support the Examiner's contention that it would have been obvious to have the judgment based on the active set so that the judgment of the transmitting base stations of the APA during handoff would be based on the actual links set up as dictated by the active set. The Examiner has failed to show any objective motivation, teaching or suggestion, aside from Applicants own disclosure, that would lead one of ordinary skill in the art to modify the APA as suggested by the Examiner. The only teaching that correlates with the Examiner purported motivation to modify is found on page 5 and 6 of Applicants' disclosure, which is as follows:

Accordingly, the base stations make a judgment by using all the defined code words as subjects of the judgment candidates, even though there are the code words with no possibility to be transmitted by the mobile station. Consequently, there is a problem of increasing wrong judgments.

Accordingly, an object of the present invention is to enhance precision of the judgment by rendering the number of the code words to be judgment candidates at the base stations small as possible and thus improving the efficiency of using code words.

(*Specification*, p. 5, lines 18-26; and p. 6, lines 9-13).

In conclusion, because the Examiner relies solely on Applicants' own disclosure without any other objective support to modify the APA, Applicants submit that the Examiner is guilty of a prohibited hindsight analysis and, thus, has failed to establish *prima facie* obviousness.

Thus, Applicants respectfully submit that claims 9 and 20-22 are allowable for at least this reason.

Additionally, the Examiner takes "official notice" that the determination of a maximum number of base stations is well known in the art, such maximum number of base stations is known in the CDMA prior art as the active set. (*Office Action*, p. 7).

The MPEP states that "[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertion of technical facts in the areas of esoteric technology or **specific knowledge of the prior art must always be supported by citation to some reference work recognized as a standard in the pertinent art.**" (MPEP § 2144.03, p. 2100-134)(emphasis added).

Here, the Examiner merely concludes that it is well known in the CDMA prior art to determine the maximum number of base stations used as the active set. Because the MPEP requires that the Examiner support that this knowledge of the prior art be supported by citation to a reference, which the Examiner has failed to do, Applicants submit that the "Official Notice" is

improper and, thus, the Examiner has failed to provide any valid motivation to modify the APA. Because this assertion of “Official Notice” does not comply with the procedure outlined in the MPEP, Applicants respectfully request that the Examiner withdraw this assertion of Official Notice or provide an object reference to support his position.

Thus, Applicants submit that for this additional reason, the Examiner’s *prima facie* case is unsupported and should be withdrawn.

Claims 12 and 24

To compensate for the above noted deficiencies of the APA, the Examiner takes official notice that assigning the same identifier (duplicate assignment) to at least two base stations is well known in the art, mainly when base stations are remote from each other. Then, the Examiner contends that it would have been obvious to one having ordinary skill in the art to assign duplicative base stations identifiers in the APA system so long as the base stations having duplicative identifiers are remote from each other. Further, the Examiner concludes that a person of skill in the art would be motivated to do so by recognizing the lack of interference between duplicative base stations identifiers when they are remote from each other.

In response, Applicants submit that the Examiner has failed to establish *prima facie* obviousness because the “Official Notice” taken by the Examiner is improper.

First, the MPEP states that “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertion of technical facts in the areas of esoteric technology or **specific knowledge of the prior art must always be supported by citation to some reference work recognized as a standard in the pertinent art.**” (MPEP § 2144.03, p. 2100-134).

Here, the Examiner merely concludes that it is well known in the art that assigning the same identifier to at least two base stations is well known in the art, mainly when base stations are remote from each other. Because the MPEP requires that the Examiner support that this knowledge of the prior art be supported by citation to a reference, which the Examiner has failed to do, Applicants submit that the “Official Notice” is improper and, thus, the Examiner has failed to provide any valid motivation to modify the APA.

Furthermore, because the “Official Notice” is improper, the suggested modification is wholly unsupported. Thus, Applicants submit that claims 12 and 24 are allowable, for at least this reason.

Claims 10, 11 and 23

To compensate for the above noted deficiencies of the APA, the Examiner takes “Official Notice” that assigning the base station identifiers in a predetermined order is well known in the art. Thus, the Examiner contends that it would have been obvious to a person of skill in the art at the time of the invention to assign base station identifiers in a predetermined order so that code words representing combinations of the base station identifiers using the unique information can be searched in an orderly fashion.

In response, Applicants submit that the Examiner has failed to establish *prima facie* obviousness because the “Official Notice” taken by the Examiner is improper.

First, the MPEP states that “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertion of technical facts in the areas of esoteric technology or **specific knowledge of the prior art must always be supported by citation to some reference work recognized as a standard in the pertinent art.**” (MPEP § 2144.03, p. 2100-134).

Here, the Examiner merely concludes that it is well known in the art to assign base station identifiers in a predetermined order. Because the MPEP requires that the Examiner support that this knowledge of the prior art be supported by citation to a reference, which the Examiner has failed to do, Applicants submit that the "Official Notice" is improper and, thus, the Examiner has failed to provide any valid motivation to modify the APA.

Furthermore, because the "Official Notice" is improper, the suggested modification is wholly unsupported. Thus, Applicants submit that claims 10, 11 and 23 are allowable, for at least this reason.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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